

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted preliminary to examination in concurrently filed Request for Continued Examination (RCE) and as a full and complete response to the Final Office Action dated December 8, 2005 (U.S. Patent Office Paper No. 12022005). In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

With the filing of the above identified application on April 22, 2004, a Claim for Priority under 35 U.S.C. §§ 119 and 120 was requested. Acknowledgment of the Claim for Priority under 35 U.S.C. §§ 119 and 120 is respectfully requested.

Also, the Examiner is respectfully advised that concurrently with this preliminary amendment and response, and Information Disclosure Statement is being submitted for consideration. Acknowledgment and consideration of this Information Disclosure Statement are respectfully requested.

Further, with the previously filed Request for Continued Examination (RCE) on November 28, 2005 an Information Disclosure Statement was filed. Included in the currently filed Information Disclosure Statement and the accompanying Form PTO-1449 is another copy of the document submitted therewith, for consideration by the Examiner.

On December 21, 2005, an interview was had with Examiner Truong, as set forth in the Interview Summary of that date. U.S. Patent No. 3,972,333 to Laveen and U.S. Patent No. 5,047,049 to Salai were discussed in relation to Claim 1. Also, proposed amendments to Claim 1 were generally discussed. Further, the decision of *In re Casey*, 370 F.2d 576 (CCPA 1967) was briefly discussed. The assistance of the Examiner is greatly appreciated.

Status of the Claims

As outlined above, Claims 1 through 6, 8 through 19, 21, 22, 28 through 31 and 52 through 89 are presently pending in this application. Claims 1 and 19 are being amended to correct formal errors, place the claims in better form and to more particularly point out and

distinctly claim the subject invention. Also, Claims 7, 20, 23 through 27 and 32 through 51 have been previously cancelled without prejudice or disclaimer. Further, new Claim 89 has been added, with new Claim 89 reading on the elected species of Figures 3A and 3B. Entry of the amendments to Claims 1 and 19, and entry of new Claim 89, are respectfully requested.

Claims 3, 4, 13 through 17 and 55 through 88 have been previously withdrawn, the withdrawn claims being directed to non-elected species, pending reconsideration and allowance of Claim 1 which, as amended, is generic to these previously withdrawn claims.

The claims that have been cancelled, and that are not readable on the elected species of Figures 3A and 3B, are cancelled without prejudice or disclaimer. Applicant hereby reserves the right to file divisional applications on any or all of these cancelled claims, as well as to additional claims directed to the non-elected species.

Additional Amendments

The specification has been being amended, as previously set forth herein, to correct formal errors and to better disclose and describe the features of the present invention as claimed. Entry of these amendments to the specification is respectfully requested.

Prior Art Rejections

Claims 1, 2, 5, 6, 8 through 12, 18, 19, 21, 22, 28 through 31, and 52 through 54 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 3,972,333 to Laveen, hereinafter referred to as the Laveen '333 patent. This rejection is respectfully traversed.

Claims 1, 2, 5, 6, 8 through 12, 18, 19, 21, 22, 28 through 31, and 52 through 54 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,047,049 to Salai, hereinafter referred to as the Salai '049 patent. This rejection is respectfully traversed.

The above rejections of Claims 1, 2, 5, 6, 8 through 12, 18, 19, 21, 22, 28 through 31, and 52 through 54 under 35 U.S.C. § 102(b) will be considered collectively.

It is respectfully submitted that the Laveen '333 Patent and the Salai '049 Patent do not disclose:

a forceps type apparatus for use with a hand, including: a pair of opposing blades, with the pair of opposing blades each having a top surface and a bottom surface and each including a proximal section, a middle section and a distal section, wherein the proximal end of the proximal section of one opposing blade connecting to the proximal end of the proximal section of the other opposing blade forming a first support location for engaging a portion of

the radial side of the palmar surface of the hand for supporting the forceps type apparatus in the hand, without placing substantial pressure on a surface of the hand located over the carpal tunnel; and the middle section of each opposing blade connecting the proximal section and the distal section of a corresponding opposing blade, with the middle section of at least one opposing blade including an extension support member having a distal surface forming a second support location for engaging at least one of the middle finger or the ring finger of the hand for supporting the forceps type apparatus in the hand, with the extension support member projecting downwardly relative to the bottom surface of the corresponding opposing blade, and with the extension support member extending transversely relative to the direction of motion of the opposing blades, as respectively recited in independent Claim 1; and

a forceps type apparatus for use with a hand, including: a pair of opposing blades, with the pair of opposing blades each having a top surface and a bottom surface and each including a proximal section, a middle section and a distal section, wherein the proximal end of the proximal section of one opposing blade connecting to the proximal end of the proximal section of the other opposing blade forming a first support location for engaging a portion of the radial side of the palmar surface of the hand for supporting the forceps type apparatus in the hand, without placing substantial pressure on a surface of the hand located over the carpal tunnel; and the middle section of each opposing blade connecting the proximal section and the distal section of a corresponding opposing blade, with the middle section of at least one opposing blade including an extension support member having a distal surface forming a second support location for engaging at least one of the middle finger or the ring finger of the hand for supporting the forceps type apparatus in the hand, with the extension support member projecting downwardly relative to the bottom surface of the corresponding opposing blade, and with the extension support member extending transversely relative to the direction of motion of the opposing blades without being in direct communication with the other of the opposing blades, as respectively recited in new independent Claim 89.

In contrast, the Laveen '333 Patent, as illustrated in Figures 1 and 2 therein, discloses a guide arm 17 provided with a series of ratchet teeth 19, and a pin 20 that extends transversely through tool holding arm 12 across opening 18 in a position such that the pin 20 engages the ratchet teeth 19, such that the engagement of the teeth 19 with the pin 20 restrains parting movement of the arms 11 and 12. (Col. 2, lines 25-41 of the Laveen '333 Patent)

Further, in contrast, the Laveen '333 Patent, as illustrated in Figure 4 therein, discloses a surgical tool 30, having the opening 18 in arm 12, but a guide arm 37 is disclosed in which the ratchet teeth 19 are eliminated, and the guide arm 37 at an end remote from the tool holding arm 11 is provided with a detent 39 along its side. The Laveen '333 Patent further discloses that when the guide arm 37 is inserted into opening 18, as the arms 11 and 12 are pressed together, the detent 39 retracts toward the guide arm 37 to pass through opening 18, after which it snaps open to prevent withdrawal of the guide arm 37 from the opening 18, noting that ideally the location of the detent 39 is such that when it bears against the underside of arm 12, after having been pressed through opening 18, shearing blades 34 and 35 are in an initial meshing position. (Col. 3, line 24 to Col. 4, line 16 of the Laveen '333 Patent)

It is respectfully submitted that, in the Laveen '333 Patent, the disclosed function of the guide arm 17 provided with a series of ratchet teeth 19 which engage with the pin 20 is for restraining movement of the arms 11 and 12, rather than a supporting function; and the disclosed function of the guide arm 37 having the detent 39 is to prevent withdrawal of the guide arm 37 from the opening 18, rather than a supporting function. Therefore, the Laveen '333 Patent does not disclose a middle section of at least one opposing blade including an extension support member having a distal surface forming a second support location for engaging at least one of the middle finger or the ring finger of the hand for supporting the forceps type apparatus in the hand, as respectively recited in the forceps type apparatus of Claim 1 and in the forceps type apparatus of new Claim 89.

Further, it is respectfully submitted that the disclosed positional relationship and movement of the arms 11 and 12 relative to the guide arm 17 in the tool 10 of figure 1 of the Laveen '333 Patent, and of the arms 11 and 12 relative to the guide arm 37 in the tool 30 of figure 4 of the Laveen '333 Patent, does not disclose the guide arm 17 or the guide arm 37 extending transversely relative to the direction of motion of the arms 11 and 12. Therefore, the Laveen '333 Patent does not disclose an extension support member extending transversely relative to the direction of motion of the opposing blades, as respectively recited in the forceps type apparatus of Claim 1 and in the forceps type apparatus of new Claim 89.

Also, the Laveen '333 Patent does not disclose the guide arm 17 or the guide arm 37 extending transversely relative to the direction of motion of the arms 11 and 12 without the guide arm 17 or the guide arm 37 being in direct communication with the other of the arms 11 and 12. Therefore, the Laveen '333 Patent does not disclose an extension support member

extending transversely relative to the direction of motion of the opposing blades without being in direct communication with the other of the opposing blades, as respectively recited in new independent Claim 89.

Therefore, it is further respectfully submitted that the forceps type apparatus of Claim 1 and the forceps type apparatus of new Claim 89 are not anticipated by the Laveen '333 Patent.

Additionally, in contrast, the Salai '049 Patent in Figures 3 and 4 therein disclose reference surfaces 50 and 52 for allowing the user to orient the needle holder 30. Further, the portion of the needle holder 30 in Figure 3 of the Salai '049 Patent, referred to by the Examiner as an "extension support member" (U.S. Patent Office Paper No. 12022005, page 4), other than apparently being illustrated in Figure 3 of the Salai '049 Patent as a part of handle 40 or 42, is not specifically identified or described in the Salai '049 Patent. (Col. 2, lines 41-63 of the Salai '049 Patent) Further, in contrast, the portion of the needle holder 30 in Figure 3 of the Salai '049 Patent, referred to by the Examiner as an "extension support member", is not disclosed as projecting downwardly relative to the bottom surface of the needle holder 30.

Therefore, it is respectfully submitted that the portion of the needle holder 30 identified in Figure 3 of the Salai '049 Patent, referred to by the Examiner as an "extension support member", does not disclose a middle section of at least one opposing blade including an extension support member having a distal surface forming a second support location for engaging at least one of the middle finger or the ring finger of the hand for supporting the forceps type apparatus in the hand, and with the extension support member projecting downwardly relative to the bottom surface of the corresponding opposing blade, as respectively recited in the forceps type apparatus of Claim 1 and in the forceps type apparatus of new Claim 89.

Further, it is respectfully submitted that the disclosed positional relationship and movement of the handles 40 and 42 relative to the portion of the needle holder 30 in Figure 3 in the Salai '049 Patent, referred to by the Examiner as an "extension support member" (U.S. Patent Office Paper No. 12022005, page 4), does not disclose such portion of the needle holder 30 in Figure 3 in the Salai '049 Patent, referred to by the Examiner as an "extension support member", extending transversely relative to the direction of motion of the handles 40 and 42. Therefore, the Salai '049 Patent does not disclose an extension support member extending transversely relative to the direction of motion of the opposing blades, as

respectively recited in the forceps type apparatus of Claim 1 and in the forceps type apparatus of new Claim 89.

Therefore, it is further respectfully submitted that the forceps type apparatus of Claim 1 and the forceps type apparatus of Claim 89 are not anticipated by the Salai '049 Patent.

Moreover, it is respectfully submitted that in addition to Claim 1 not being anticipated by the Laveen '333 Patent or the Salai '049 Patent, dependent Claims 2, 5, 6, 8 through 12, 18, 19, 21, 22, 28 through 31, and 52 through 54 are likewise not anticipated by the Laveen '333 Patent or the Salai '049 Patent, and are at least allowable for the same reasons that Claim 1 is allowable.

In view of the foregoing, withdrawal of the above identified rejections of Claims 1, 2, 5, 6, 8 through 12, 18, 19, 21, 22, 28 through 31, and 52 through 54 under 35 U.S.C. § 102(b) is respectfully requested.

Reconsideration and allowance of Claims 1, 2, 5, 6, 8 through 12, 18, 19, 21, 22, 28 through 31 and 52 through 54, consideration and allowance of new Claim 89, and consideration and allowance of withdrawn claims 3, 4, 13 through 17 and 55 through 88, are respectfully requested.

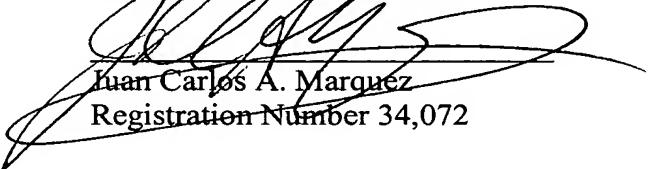
Conclusion

In view of all the above, Applicant respectfully submits that certain clear and distinct differences as discussed exist between the present invention as now claimed and the prior art references upon which the rejections in the Office Action rely. These differences are more than sufficient that the present invention as now claimed would not have been anticipated nor rendered obvious given the prior art. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application as amended is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and phone number indicated below.

Respectfully submitted,

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December 30, 2005

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